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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,517	08/07/2003	Matsutaro Matsui	537921	8455

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EXAMINER
SCHUBERG, LAURA J

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,517

Applicant(s)

MATSUI ET AL.

Examiner

Laura Schuberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/04/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating male sterility, does not reasonably provide enablement for preventing male sterility. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors to be considered in determining whether undue experimentation is required are summarized in *re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988). The court in *Wands* states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (*Wands*, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction or guidance presented (3) the

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presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. While all these factors are considered, a sufficient number are discussed below so as to create a prima facie case.

The claims are drawn to a pharmaceutical or a health food for preventing or treating male sterility comprising oyster extract and ginseng extract as an active ingredient. While the person of ordinary skill in the art would have a reasonable expectation of successfully treating male sterility by administering the claimed composition, there would not be such a reasonable expectation for preventing male sterility. Male sterility has many different causes as taught by Dr. Sayeed Ahmad (www.Homeoint.org) and Ferlin et al (Reproductive Technology). Ahmad teaches that male sterility may be caused by short and curved penis, undescended or atrophied testes, defective seminal charges due to diseases such as mumps, tuberculosis, gonorrhea, etc. (page 3). It is unclear how Applicant's claimed composition would be able to prevent male sterility caused in these ways. In addition Ferlin teaches that genetic causes account for 10-15 % of severe male infertility (abstract). Clearly, Applicant's claimed invention would not be able to prevent male sterility caused by chromosomal aberrations and single gene mutations.

Therefore, one of ordinary skill in the art would not have a reasonable expectation of successfully preventing male sterility with Applicant's claimed composition.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hozumi et al (JP 2002-173434).

Claims 1-6 are drawn to pharmaceutical compositions and health foods that comprise an oyster extract and a ginseng extract as active ingredients.

Hozumi teaches a composition that comprises an aqueous extracted essence of Panax ginseng and oyster shell (abstract). While the referenced composition does not teach the same characteristics of treating male sterility or effecting sperm count, these characteristics are considered to be inherently present since the referenced composition contains the same ingredients as Applicant's claimed composition.

To invalidate a patent by anticipation, a prior art reference normally needs to disclose each and every limitation of the claim. See *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). However, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See *id.* and *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See *In re King*, 801

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F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). **Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art.** See *Titanium Metals*, 778 F.2d at 780. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. See *id.* at 782. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. See *id.* at 782 ("Congress has not seen fit to permit the patenting of an old [composition], known to others..., by one who has discovered its...useful properties."); *Verdegaal Bros.*, 814 F.2d at 633.

This court's decision in *Titanium Metals* illustrates these principles. See *Titanium Metals*, 778 F.2d at 775. In *Titanium Metals*, the patent applicants sought a patent for a titanium alloy containing various ranges of nickel, molybdenum, iron, and titanium. The claims also required that the alloy be "characterized by good corrosion resistance in hot brine environments." *Titanium Metals*, 778 F.2d at 776. A prior art reference disclosed a titanium alloy falling within the claimed ranges, but did not disclose any corrosion-resistant properties. This court affirmed a decision of the PTO Board of Appeals finding the claimed invention unpatentable as anticipated. This court concluded that the claimed alloy was not novel, noting, "it is immaterial, on the issue of their novelty, what inherent properties the alloys have or whether these applicants discovered certain inherent properties." *Id.* at 782. This same reasoning holds true when it is not a property, but an ingredient, which is inherently contained in the prior art. The public remains free to make, use, or sell prior art compositions or processes,

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regardless of whether or not they understand their complete makeup or the underlying scientific principles which allow them to operate. The doctrine of anticipation by inherency, among other doctrines, enforces that basic principle." See *Atlas Powder Co. v. IRECO Inc.*, 51 USPQ2d 1943 (Fed. Cir. 1999).

Thus, a reference may be anticipatory if it discloses every limitation of the claimed invention either explicitly or inherently. A reference includes an inherent characteristic if that characteristic is the natural result flowing from the reference's explicitly explicated limitations. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Therefore, Hozumi anticipates the claimed subject matter.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuchi et al (JP 360066960A).

The claims are drawn to the compositions as described above.

Tuchi teaches a food containing oyster extract and ginseng extract (abstract). The characteristics of the composition as claimed by Applicant are inherent as described in the above rejection. Therefore, Yuchi anticipates the claimed subject matter.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Li (CN 1089864A).

The claims are drawn to the composition as described above.

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Li teaches a preparation used to make a drug addict give up drug taking and comprises extracts of red ginseng and oyster shell (abstract). The characteristics of the composition as claimed by Applicant are inherent as described in the above rejection. Therefore, Li anticipates the claimed subject matter.

Conclusion

No claims are allowed.

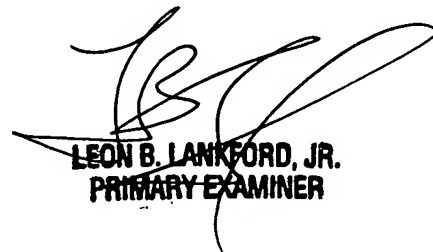
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Schuberg whose telephone number is 571-272-3347. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura Schuberg



LEON B. LANKFORD, JR.
PRIMARY EXAMINER